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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/972,760

10/05/2001

Akihiko Toyoshima

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07/07/2006

ROGITZ & ASSOCIATES

750 B STREET

SUITE 3120

SAN DIEGO, CA 92101

EXAMINER

NGUYEN, STEVEN H D

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/972,760

Applicant(s)

TOYOSHIMA, AKIHIKO

Examiner

Steven HD Nguyen

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2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,10,11,13,15,17-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,10,11,13,15,17-19 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/05, 3/05, 6/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment filed on 5/1/06. Claims 6-9, 12, 14, 16 and 20 have been canceled and claims 1-5, 10-11, 13, 15, 17-19 and 21 are pending in the application.

### ***Specification***

2. The disclosure is objected to because of the following informalities: Page 1, the applicant must fill the application number into the blanks.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 18 recites the limitation "said operation data" in lines 1 is vague and indefinite because it's unclear if the applicant refers to the first or second operation data. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 11 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanava (USP 5450471).

Regarding claims 1, 11 and 17, Hanawa discloses a method and system for providing a multiple format wireless phone (Figs 6-7, 10, 11 and 15) comprising a wireless phone (Fig 6, Ref 1, Figs 7 and , Ref 11, Fig 11, Ref 730 and Fig 15, Ref 780) having a first wireless communication format (Analog or digital, first or second system, Col. 3, lines 9-13) configured to removably receive at least one wireless module (Fig 7, Ref 13, Fig 10, ref 13A, Fig 11, ref 710 and Fig 15, ref 760)having a second wireless communication format (Analog or digital, first or second system, Col. 3, lines 9-13) and said wireless module in electronic data communication with the wireless phone (Figs 7, 10-11 and 15, the telephones is coupled via electronic data communication), said wireless module configured to provide the second format to the phone (Analog or digital, first or second system, Col. 3, lines 9-13), wherein the module includes a mobile station identification number, said wireless phone configured to receive said mobile station identification number upon verification of proper operation of the module to facilitate use of a single phone number with both formats (Fig 6, Ref 9 and 10 used to verify the conditions of the portable telephone and transferring the conditions information and subscriber's number etc... to the wireless phone; Fig 6, Ref 1, Figs 7 and , Ref 11, Fig 11, Ref 730 and Fig 15, Ref 780, so

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that the telephones can be use with the same telephone number, See col. 9, lines 48-50, col. 11, lines 55 to col. 12, lines 24).

Regarding claim 18, Hanawa discloses operational data comprises at least one wireless format (Analog or digital, first or second system, Col. 3, lines 9-13).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-5, 10, 13, 15, 19 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Hanava in view of Metroka (USP 5249302).

Regarding claims 2-3, 13 and 21, Hanawa fails to disclose providing at least one wireless module comprises utilizing at least one wireless format selected from the group consisting of CDMA ONE, CDMA 2000 1X, CDMA 2000 3X, CDMA 1X EV, Wideband CDMA, GSM, GPRS and EDGE. In the same field of endeavor, Metroka discloses a multiple mode telephone system herein a wireless module utilizing at least one wireless format selected from the group consisting of CDMA, TDMA "GSM" (Col. 12, lines 19-39).

Since, Hanawa discloses a dual mode telephone system containing two formats such analog and digital. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply CDMA and TDMA format as disclosed by Metroka

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into the system and method of Hanawa. The motivation would have been to utilize of additional transmission capacity of cellular communication system.

Regarding claims 4-5, 10, 15 and 19, Hanawa fails to disclose providing said wireless module with an electronic serial number for storing to wireless phone. In the same field of endeavor, Metroka discloses providing said wireless module with an electronic serial number for storing to wireless phone (Col. 14, line 62 to col. 15, Line 3 and col. 15, lines 32-38 and col. 17, lines 1-28).

Since, Hanawa discloses a dual mode telephone system containing two formats such analog and digital wherein a wireless module provides a subscriber's number such as ID information to the wireless phone. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for providing the radiotelephone serial number of the wireless module to the wireless telephone as disclosed by Metroka into the system and method of Hanawa. The motivation would have been to utilize of additional transmission capacity of cellular communication system.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yamashita (USP 5809432) discloses a system and method for inserting or removing a wireless module of a wireless phone.

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Shamlou (USP 6690949) discloses a handset comprising an interface for coupled to a detachable wireless module in order to allow a traveler to exchange a different module when travels to a different region and registered with the visitor network.

Poole (GB 2292653) discloses a mobile system which includes the interface for inserting the modules in order to allow the mobile device to communicate in multiple modes wherein a single telephone number is programmed into a wireless phone.

Kuisma (USP 6259929) discloses a mobile system which includes the interface for inserting the modules in order to allow the mobile device to communicate in multiple modes.

Tom (USP 6690947) discloses a mobile system which includes the interface for inserting the modules in order to allow the mobile device to communicate in multiple modes.

Grimmett (USP 5259018) discloses a system for allowing the NAM of portable to be transferred to the mobile which allows the mobile assuming the same telephone number of the portable device when the portable and mobile are attached to each other via electronic means.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (571) 272-3159. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571) 272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Steven HD Nguyen', with a long horizontal line extending to the right.

Steven HD Nguyen  
Primary Examiner  
Art Unit 2616  
June 26, 2006